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BACON & THOMAS, PLLC  
625 SLATERS LANE  
FOURTH FLOOR  
ALEXANDRIA, VA 22314

EXAMINER

GLESSNER, BRIAN E

ART UNIT	PAPER NUMBER
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3635

DATE MAILED: 02/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/869,299

**Applicant(s)**CAPPELLE, MARK GASTON  
MAURITS**Examiner**

Brian E. Glessner

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 October 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-46 and 49-51 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15, 17-30, 32, 34-46 and 49-51 is/are rejected.
- 7) ☒ Claim(s) 16, 31 and 33 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Priority***

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Information Disclosure Statement***

The applicant submitted a search report containing a list of references. The examiner would like to point out that the references listed on the search report will not be listed on the front of the patent, if the application issues as a patent, unless the applicant submits an Information Disclosure Statement (PTO 1449) listing the references on the search report for the examiner to initial and sign. If the references are listed on a Notice of References Cited (PTO 892), the applicant does not need to submit a PTO 1449.

### ***Specification***

2. The disclosure is objected to because of the following informalities: The specification does not contain headings, which distinguish the various parts of the disclosure, i.e. Summary of the Invention, Background of the Invention, Description of the Drawings, etc.

Appropriate correction is required.

### ***Claim Objections***

3. Claims 31 and 33 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot be dependent upon two claims. It can only be dependent upon one claim. See MPEP § 608.01(n). Accordingly, the claims have not been further treated on the merits.

Claims 1, 10, and 15 are objected to because of the use of the phrases “on the one hand” and “on the other hand”. Said phrases are confusing and do not help to clarify the claim. The use of said phrases makes the claim seem confusing and harder to understand. The examiner believes that the claims would be more concise and clear if the above phrases were left out of the claims.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 3, 7, 26, 34, and 38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. Regarding claims 3, 7, and 34, the phrase "for example" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Regarding claims 26 and 38, the phrase “and/or” renders the claim indefinite because it is unclear whether the claim includes all of the limitations before and after the phrase “and/or”, or if the claim only includes the limitations before or only the limitations after the phrase “and/or”. Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

8. Claims 1-4, 6-15, 17-26, 28-30, 32, 36, 37, 39, 42-44, 46, and 49-51 are rejected under 35 U.S.C. 102(b) as being anticipated by Gwyther (4,395,858).

In regard to claims 1-3 and 6, Gwyther discloses a covering for a surface comprising a number of successive panels 14, 114, and fixing means 12, said fixing means comprising holders including fixing parts 38, 40, 38a, 40a, said fixing parts arranged to engage and retain the panels in a disconnectable manner over a part of the thickness of the panels. Said panels are mounted in rows, and in that the panels can be separated from the respective holders and removed without interference with adjacent panels. The holders are each provided with at least two fixing parts 38, 40, 38a, 40a made in one piece with the holders, and which are arranged so as to co-operate with two edges or portions of one and the same panel respectively, or with portion situated in the vicinity thereof, figures 2 and 6.

In regard to claim 4, Gwyther discloses the claimed invention, wherein the holders comprise separate elements 36, 36a, which can be fixed on a base, and wherein each holder cooperates with a respective single panel.

In regard to claim 7, Gwyther discloses the claimed invention, including a spacer 10 and wherein said holders co-operate with said spacer.

In regard to claim 8, Gwyther discloses the claimed invention, wherein each holder includes a stopping part 46, wherein the stopping part is capable of being positioned against a part of the covering which has already been installed, against a holder thereof, or against a panel thereof.

In regard to claim 9, Gwyther discloses the claimed invention, wherein the stopping part is formed of a protruding lip, which can inherently function as a spacer.

In regard to claim 10, Gwyther discloses the claimed invention, wherein the stopping part of the holder can be freely brought up against the edge of the panel that is being held by an adjacent holder, figure 6.

In regard to claim 11, Gwyther discloses the claimed invention, wherein every holder is provided with at least one stopping part on one edge, and opposite said stopping part with a portion that leaves the edge of a clamped-in panel free. The holder does not contain any portions opposite the stopping part. Therefore, the panel edge is free.

In regard to claim 12, Gwyther discloses the claimed invention, wherein the holders include clamping devices 36, 36a, which are arranged so as to enable the holders to be snapped-in on an underlying structure.

In regard to claims 13-15, Gwyther discloses the claimed invention, wherein each holder includes fixing parts 38, 40, 38a, 40a, which cooperate with the panels and facilitate a smooth lateral, flexible bending, so that in a direction perpendicular to the surface of the covering a firm interlock is enabled. Each of said fixing parts is formed of elastically bendable lips and at least one of lips is formed into a hook shaped portion 38, 38a, and the other of the lips is formed with a rigid hook-shaped part (40 and the portion connected to portion 40) and an inclined guiding part 40a.

In regard to claims 17-19, Gwyther discloses the claimed invention, wherein the panels overlap each other at their adjacent edges, figure 6. The panels also include overlapping parts on the opposite edges, whereby, when mounted, a first part 122 of one panel is located behind a second part 120a of an adjacent panel, and wherein a recess or free portion is provided on the second part, such that one panel can always be freely rotated outward along the first part. The panels are also meshed together and can inherently be shifted in the manner described in claim 19. Although Gwyther does not specifically state all of the ways the panels can be moved, the examiner would like to point out that Gwyther discloses all of the structural features of applicant's claimed invention. Therefore, it is inherent that two devices having the same structural features are capable of performing the same functions.

In regard to claim 20, Gwyther discloses the claimed invention, wherein each respective fixing part includes a guiding part 38a, 40a, which inherently allows the system to function as claimed by applicant.

In regard to claims 21-23, Gwyther discloses the claimed invention, wherein said holders include gripping means 36, 36a, which provide a tight grip when said holder is secured on a base.

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Said gripping means comprise points of support 36a, which are located on either side of a fixing point, i.e. the middle of the holder, and which are made such that the holder is slightly bent when being secured, so that the holder is tightened against the base on said points of support when secured to on said base. The holders each only include one fastener fixing point, i.e. the center of the hold between the members 36.

In regard to claims 24 and 25, Gwyther discloses the claimed invention, wherein the holders include a positioning means 36. The examiner would like to point out that the means 36 can be used to represent both the gripping means disclosed in claims 21 and 22 as well as the positioning means disclosed in claims 24 and 25 because claims 21 and 22 and 24 and 25 are not dependent upon each other. They are dependent upon claim 1. Thus, the means 36 could represent either the gripping means or the positioning means. The positioning means 36 further comprises a supporting surface enabling the holder to be laterally pressed against a base, said supporting surface comprising an L-shaped seating together with the bottom side of the holder.

In regard to claim 26, Gwyther discloses the claimed invention, wherein the panels or the fixing parts are provided with beveled or rounded-off edges, which facilitate the turning in and out of the panels, figures 2, 3, and 6.

In regard to claim 28, Gwyther discloses the claimed invention, wherein the each holder comprises only one pair of fixing parts 38, 38a and 40, 40a per panel to be held.

In regard to claims 29, 30, 32, 36, and 37, Gwyther discloses the claimed invention, wherein the panels mesh on their edges by means of a tongue and groove joint, either directly or by means of an inserted element such as a strip, figure 6. The fixing means, as well as the tongue and groove joint, enable the panels to be rotated along the side of the tongue or groove



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during assembly and disassembly of the panels and holders. Once again, since the panels disclose all of the structural features of the applicant's claims, they are inherently capable of performing the same functions as applicant's claimed panels. Gwyther's panels further include a part of the tongue and groove that is located outside a respective fixing part when mounted. The tongue and groove are both located outside the fixing part when mounted, figure 6. The tongue and groove, or fitting parts, are each situated on one longitudinal edge of the panels and extend up to the "vicinity" of the fixing part of a following panel to be mounted.

In regard to claim 39, Gwyther discloses the claimed invention, wherein the panels consist of laths.

In regard to claims 42 and 43, Gwyther discloses the claimed invention, wherein the panels have a "massive" core and are made of wood.

In regard to claim 44, Gwyther disclose the claimed invention, wherein the holders include fixing parts on one side which are formed of a rigid, hook-shaped part.

In regard to claim 46, Gwyther discloses the claimed invention, wherein said holders comprises strips and said fixing means are formed of fixing parts protruding from the surface of said strips. Gwyther does not specifically refer to his covering as a floor covering. However, Gwyther's covering contains all of the limitations of the applicant's covering. Therefore, Gwyther's covering is inherently capable of being used as a floor covering.

In regard to claims 49-51, Gwyther discloses the claimed method for installing a covering formed of panels, which are provided with a tongue and a groove respectively on at least two opposite edges, comprising mounting holders 12 with fixing parts 38, 40, 38a, 40a, which can work in conjunction with said panels, and then hooking each panel in a respective holder with

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one panel edge and then rotating the panel into the plane of the covering so that not only are the panels fixed between the fixing parts of the holders, but also said tongue and groove are coupled together. The panels are also shifted so that the panels with their edge, which is provided with the groove over the tongue of a previously installed panel, or vice versa, said interlocking part of the holder being laterally bent, so that a hooking-in is achieved on the opposite interlocking part. Gwyther also disclose a method of removing the panels by reversing the steps disclosed in claims 49 and 50.

9. Claims 1 and 5 are rejected under 35 U.S.C. 102(e) as being anticipated by Pervan (6,516,579).

In regard to claims 1 and 5, Pervan discloses a covering for a surface comprising a number of successive panels 1, 2 and fixing means (figures 2a-2c), said fixing means comprising holders including fixing parts 34, 54, 56, said fixing parts arranged to engage and retain the panels in a disconnectable manner over a part of the thickness of the panels. The holders comprise elements, which can be fixed on a base, and wherein each holder includes fixing devices, which are arranged to co-operate with several panels situated next to each other.

10. Claims 1, 37, and 38 are rejected under 35 U.S.C. 102(e) as being anticipated by Whitehouse et al. (6,421,974).

In regard to claims 1, 37, and 38 Whitehouse discloses a covering for a surface comprising a number of successive panels 20 and fixing means, figure 3, said fixing means comprising holders including fixing parts 3, 4, 6, 8, said fixing parts arranged to engage and retain the panels in a disconnectable manner over a part of the thickness of the panels. The holders comprise elements, which can be fixed on a base, and wherein each holder includes

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fixing devices, which are arranged to co-operate with several panels situated next to each other.

The panels are provided with parts 24, 32 fitting one after the other, and in that the part, which is situated on one longitudinal edge of the panels, extends up to the vicinity of and underneath or past the fixing part of a following panel to be mounted.

11. Claims 1 and 27 are rejected under 35 U.S.C. 102(e) as being anticipated by Watanabe (6,266,937).

In regard to claims 1 and 27, Watanabe discloses a covering for a surface comprising a number of successive panels 10 and fixing means, figure 10, said fixing means comprising holders including fixing parts 26a, 26b, said fixing parts arranged to engage and retain the panels in a disconnectable manner over a part of the thickness of the panels. The holders each comprise at least two pairs of fixing parts per panel to be held, said pairs situated on either side of a stopping part 26C, 26D located in the middle of the holder.

***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 34 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gwyther (4,395,858) in view of Mosch (4,546,587).

In regard to claims 34 and 35, Gwyther discloses the claimed invention except for specifically disclosing that the panels co-operate indirectly at their edges by means of inserted elements that are connected to one panel such that they always occupy a specific lateral position.

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Mosch teaches that it is known to connect panels using inserted elements 7 that always occupy a specific lateral location. It would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute Mosch's means for Gwyther's tongue and groove, because the inserted means will provide a more pleasing esthetic effect to the cover system. The inserted means will break up the surface and give it a more three dimensional look. Further, the inserted means will securely interlock the panels together.

14. Claims 40 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gwyther (4,395,858) in view of Pervan (6,516,579).

In regard to claims 40 and 41, Gwyther discloses the claimed invention except for specifically disclosing that the panels included connecting devices on their crosscut sides, wherein the connecting devices provide for an interlocking, both in a direction which is at right angles to the surface of the covering and in a direction parallel to the surface of the covering. Pervan teaches that it is known to attach panels along their longitudinal sides and their crosscut sides to provide an interlocking means, figures 4a and 4b. It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the connecting devices on the crosscut sides of Gwyther's invention, because the connecting devices will prevent the ends of the panels from becoming misaligned. They will also prevent one panel from becoming higher than an adjacent panel.

15. Claim 45 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gwyther (4,395,858).

In regard to claim 45, Gwyther discloses the claimed invention, except for specifically disclosing that two or more panels are connected at their crosscut ends by means of an accessory

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having a body and bent edges formed on said body which co-operate with the edges of the panel.

Gwyther's clip 12 has a body and bent edges that co-operate with the edges of the panels. It would have been obvious to one having ordinary skill in the art at the time the invention was made to locate at least one of the clips 12 at the ends of two adjacent panels, because by placing the member 12 at the ends of two adjacent panels, the member 12 will prevent the ends from moving or becoming uneven. Further, rearranging parts of an invention involves only routine skill in the art.

#### ***Allowable Subject Matter***

16. Claim 16 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. This holding of allowable subject matter is provisional and subject to reconsideration upon receipt of the amended claims to comply with the specifications set forth in 35 U.S.C. 112, second paragraph.

17. The following is a statement of reasons for the indication of allowable subject matter: The prior art references of record fail to show or teach the limitations as specifically set forth in applicant's claim 16. The examiner can find no proper motivation to combine the references of record to produce applicant's claimed invention.

#### ***Conclusion***

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Geisinger, Routt, Mancuso, Duffy, Andres, Fritz et al., Little, and Addie et al.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian E. Glessner whose telephone number is 703-305-0031.

The examiner can normally be reached on Monday-Friday 7:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl D. Friedman can be reached on 703-308-0839. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-2168.

B.G.  
February 20, 2003



BRIAN E. GLESSNER  
PATENT EXAMINER